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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,805	08/30/2001	Serge Restle	05725.0927	6749

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,805

Applicant(s)

RESTLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-76 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 24-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claims 24, 34-37, 49, 74, and 75, drawn to a composition and method of using thereof, which comprises the esters in claim 24 (C)(1).

Group II, claims 24, 34, 35, 37, 38, 49, 74, and 75, drawn to a composition and the method of use thereof, which comprises the esters in claim 24 (C)(2).

Group III claims 24, 34, 38, 39, 49, 74, and 75, drawn to a composition and method of using thereof, which comprises the esters in claim 24 (C)(3).

Group IV, claims 24, 34 - 36, 40, 49, 74, and 75, drawn to a composition and the method of use thereof, which comprises the esters in claim 24 (C)(4).

Group V claims 24, 34, 41-43, 49, 74, and 75, drawn to a composition and method of using thereof, which comprises the esters in claim 24 (C)(5).

Group VI, claims 24, 34, 36, 49, 74, and 75, drawn to a composition and the method of use thereof, which comprises the esters in claim 24 (C)(6).

Group VII claims 24, 34 - 36, 44, 49, 74, and 75, drawn to a composition and method of using thereof, which comprises the esters in claim 24 (C)(7).

Group VIII, claims 24, 34, 36, 45, 46, 49, 74, and 75, drawn to a composition and the method of use thereof, which comprises the esters in claim 24 (C)(8).

Group IX claims 24, 34, 36, 47, 49, 74, and 75, drawn to a composition and method of using thereof, which comprises the esters in claim 24 (C)(9).

Group X, claims 24, 34, 35, 38, 48, 49, 74, and 75, drawn to a composition and the method of use thereof, which comprises the esters in claim 24 (C)(10).

Claims 25-33, 50-73, and 76 link inventions I-X. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 25-33, 50-73, and 76. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions I-X are distinct, each from the other because:

The subject matter in a claim lacks unity of invention. Unity of invention exists where compounds included within a Markush group share a common utility and share a substantial structural feature disclosed as being essential to that utility. In this case, claims 24, 34, 74, and 75 present ten different groups of esters that are not closely related so that a search and examination of the entire claims cannot be made without serious burden. No unity of invention exists since the esters, while sharing a common utility as a conditioning agent for hair, there is no common *substantial* structural feature disclosed as being essential to that utility. In this case, there is no substantial structural

feature shared among the claimed esters since they are derivatives from diverse and distinct chemical groups.

These inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and their different classification. Because the search required for one invention is not required for others, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
March 12, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

3/18/03